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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/030,989	02/26/1998	RICHARD A. NAZARIAN	28724/34520	8085

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EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT PAPER NUMBER

2635

DATE MAILED: 04/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/030,989

Applicant(s)

NAZARIAN

Examiner

Brian Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-38 is/are pending in the application.
- 4a) Of the above claim(s) 23-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Application

In response to the applicant's amendment received on 2/11/02. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 16-22 remain unpatentable for the reasons set forth in this office action:

Election/Restrictions

1. Newly submitted claims 23-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 23-38 are directed to a medical perfusion system classified in class 604. As the applicant has previously stated on page 2 of paper number 10 (response filed 6/9/00) this division is directed to an invention not elected in the parent (now US Pat. 5813972). Claims 23-38, however, are directed to the invention elected (and prosecuted) in the parent application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dais (5524213), Omori (5820414), together or alternatively in combination with Schenk (5444626).

Dais shows a system that can be used as a medical communication system that includes a bus and interface units connected to the bus and also to peripheral units. See col. 1 line 11+. The interface units generate messages in the form of digital data packets. Dais does not expressly show the interface unit to be within a housing and have different shaped coupling means for coupling to the bus, and the peripheral.

Although Dais does not expressly show the communication system used in a medical perfusion system, it is the examiner's position that medical perfusion systems commonly used communications systems. As an example, Sites shows a medical perfusion system that requires a communication system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the above modified communication system to provide communication for a medical perfusion system, as Sites shows a communication system for a medical perfusion system and leaves it up to the artisan to choose an appropriate communication system.

In an analogous art, Omori shows an interface adapter that connects a circuit board 1 to a bus 19a. The interface adapter includes processing elements 16 and 17

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and includes connector means which have different shaped couplers as claimed, to provide connection and improvement of the IC card. Omori shows a controller, which provides power to the slave device through the adapter. See col. 7 lines 38+.

The examiner takes note that a perfusion device is a well-known medical instrument that would have fallen under the medical application taught by Dais.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized an interface unit in the shape of Omori in the Dais system in order to provide connection and improvement to the peripheral unit of Dais.

With regard to the "adapted to" limitation, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. If such a limitation were given weight, it is submitted that Dais shows the modules 2-5 which communicate to the control unit 1 in addition to other modules. Additionally Schenk (5444626) also shows a communication adapter (pod), which communicates information to other modules in addition to a control unit.

Although Dais does not expressly show the communication system used in a medical perfusion system, it is the examiner's position that medical perfusion systems commonly used communications systems. As an example, Sites shows a medical perfusion system that requires a communication system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the above modified communication system to provide communication for a medical

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perfusion system, as Sites shows a communication system for a medical perfusion system and leaves it up to the artisan to choose an appropriate communication system.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 5752931. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elements now claimed which are not present in the '931 patents (i.e. a housing, a selective power supply and limitation to the number of communication lines) are very common in communication systems.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a communication system for a medical perfusion system.


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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Zimmerman whose telephone number is 703-305-4796. The examiner can normally be reached on every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Brian Zimmerman
Primary Examiner
Art Unit 2635

BaZ
April 18, 2002